

ADDITIONAL FEE:

Please charge any insufficiency of fee, or credit any excess, to Deposit Account No. 50-0427.

R E M A R K S

The Office Action issued March 6, 2008 has been received and its contents have been carefully considered.

The applicant wishes to thank the Examiner in charge of this application, Dr. James Rogers, for the courtesy and cooperation he extended to applicant and his undersigned counsel during the telephone interview kindly granted on May 22, 2008.

1. Claim Rejections 35 USC 112:

In accordance with the Examiner's suggestion, the limitation pertaining to the term "carrier" has been deleted in the amended independent claims. The compositions as claimed have been more appropriately modified and defined as "comprising a homogeneous and stable aqueous form of a graft copolymer selected from the group consisting of a solution, an emulsion and a dispersion, that forms at least one of a lotion, a cream, a gel, a petrolatum and a wax-based preparation, for treatment of mammalian skin,..."

This definition is consistent with that described in the paragraph [0020] of the published patent application as shown below:

"The present invention is directed to a bioadhesive, hydrophilic polymer film forming composition, comprising a water-insoluble graft copolymer (Copolymer), in the form of a solution, lotion, cream, film, or petrolatum or wax based preparations for treatment of mammalian skin."

2. Claim Rejections 35 USC 103 - over Morrissey, etal.

The applicant has defined the graft copolymer suitable for use in this invention as one having a hydrophilic main chain and hydrophobic polystyrene side chains. The Examiner stated in his current office action (Page 5) that the graft chains of the Morrissey graft copolymer could comprise of some hydrophobic monomers such as styrene, and therefore they overlap the claimed range of the present application. The Examiner further pointed out that since the term "comprising" is used in defining the hydrophobic graft chains of the current application, the hydrophilic monomers of Morrissey are not excluded from the claimed graft chains.

In response to the Examiner's rejection, the term "comprising" has been changed to "consisting" in the present amended independent claims as shown below:

"...and a hydrophobic polymeric side chain ~~comprising~~  
consisting of polystyrene, the said graft copolymer  
being a reaction product of:

- (1) a polystyrene macromonomer having an ethylenically unsaturated functional group,
- (2) at least one hydrophilic acidic monomer having an ethylenically unsaturated functional group, and
- (3) optionally said hydrophilic neutral monomers having an ethylenically unsaturated functional group;..."

The term "consisting of polystyrene" and the further definition of the mode of the graft copolymer formation by reaction of a polystyrene macromonomer (a component forming the graft chain) with hydrophilic monomers, which form the main chain of the graft copolymer, eliminate any interpretation of possible use of hydrophilic monomers or hydrophilic graft chains in the claims of the present invention. In polymerization of the monomers described in the application, the only way the graft chains can be formed in the copolymer is by virtue of the macromonomer structure.

The claims clearly limit the copolymer as that formed by copolymerization of the polystyrene macromonomer.

Therefore, the graft chains can be only polystyrene and there is no possibility of inclusion of hydrophilic monomers

in the graft chains as defined. The currently amended independent claims thus overcome the deficiency pointed out by the Examiner.

The applicant stresses that the graft copolymers of Morrissey are distinctly different from those of the present application. The graft side chains of the Morrissey graft copolymer are specifically defined as HYDROPHILLIC, whereas those of the present application are HYDROPHOBIC, and further specified as polystyrene. This and other key differences were fully addressed in applicant's response to the previous Office Action dated November 30, 2007.

In summary, the graft copolymers of Morrissey and the present invention are both structurally and chemically very different entities. It is well known that different polymers behave differently. Therefore, the claims of the present invention cannot be considered obvious from the Morrissey patent disclosures.

The claim 21, which is drawn to a method of treating mammalian skin with the bioadhesive film forming composition, was rejected in view Morrissey, the argument being that the method produces a composition similar to that described by Morrissey. Now that a clear distinction has been drawn between the Morrissey compositions and those of

the present invention, allowance of the claim 21 is respectfully requested.

3. Claim Rejections 35 USC 103-oVER SHAH in view of Morrissey, et al.

The Examiner has also rejected the claims over Shah '243 patent in view of Morrissey. The stated basis for the rejection is that the present application discloses the same graft copolymers as Shah '243 patent and Morrissey discloses that "compositions comprised of graft copolymers within the scope of applicant's claimed invention could form homogeneous dispersions with water" and that such compositions could be used in products for application to skin.


As was stated in the previous section, the current amended claims pertain to graft copolymers, which are clearly shown to be structurally and chemically very different entities from those disclosed by Morrissey. Thus, Morrissey's compositions do not fall within the scope of the claimed invention of the present application. Therefore, the properties and performance of the graft copolymers of the present invention can be neither anticipated nor considered obvious from those of Morrissey.

The Examiner has acknowledged that Shah '243 patent does not disclose either (i) homogenous and stable aqueous forms of the graft copolymers of the present claimed composition or (ii) their use in skin care products such as facial make-up. The applicant has also pointed out in response to the previous Office Action (November 30, 2007), and during a subsequent personal interview with the Examiner, that hydrogel forming polymers do not necessarily form such stable aqueous forms.

Therefore, the applicant contends that, as now amended, the claimed compositions of the present invention are not obvious from Shah '243 by itself, or in combination with Morrissey et al.

Accordingly, this application is now believed to be in condition for immediate allowance. A formal Notice of Allowance is accordingly respectfully solicited.

Respectfully submitted,


By   
Karl F. Milde, Jr.  
Reg. No. 24,822

MILDE & HOFFBERG, LLP  
10 Bank Street - Suite 460  
White Plains, NY 10606

(914) 949-3100

I hereby certify that this correspondence is being deposited with the United States Postal Services as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, - *only for US 2238-1450*  
on 5-29-08

16

By   
Date 5-29-08